

REMARKS

Applicant has canceled claims 10, 12, 14, and 16, without prejudice or disclaimer of their subject matter, and amended claim 9 to more appropriately define the present invention. Applicant has amended claims 13 and 15 to conform to the amendments to claim 9 and to provide proper antecedent basis. Claims 9, 11, 13, and 15 remain pending and under current examination.

Regarding the Office Action:

In the Office Action, the Examiner rejected claims 9-16 under 35 U.S.C. § 102(e) as being anticipated by Kobayashi (U.S. Patent No. 5,909,626). Applicant traverses the rejection, for the following reasons.¹

Regarding the Claim Amendment:

Support for the amendments to claims 9, 13, and 15 may be found in the specification at, for example, page 28, lines 8-13, and Fig. 5.

Rejection of Claims 9-16 under 35 U.S.C. § 102(e):

Applicant respectfully traverses the rejection of claims 9-16 under 35 U.S.C. § 102(e) as anticipated by Kobayashi. The rejection of claims 10, 12, 14, and 16 has been rendered moot by the cancellation of these claims, without prejudice or disclaimer of their subject matter.

In order to properly establish that Kobayashi anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the

¹ The Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein, Applicant declines to automatically subscribe to any statements in the Office Action.

... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicant’s amended independent claim 9 recites, in part,

a plurality of first single crystalline semiconductor layers formed on the buried insulating film; at least one second single crystalline semiconductor layer formed in the second region and in contact with the semiconductor substrate; *a plurality of element isolation regions which insulate at least one of the first single crystalline semiconductor layers from the second single crystalline semiconductor layer, and insulate the first single crystalline semiconductor layers from each other*; and element isolation insulating films in the element isolation regions having the same height from the semiconductor substrate, *and wherein the first single crystalline semiconductor layers have different thickness from one another* (italics added).

Kobayashi does not disclose each and every element of Applicant’s claimed invention, despite the Examiner’s allegations. The Examiner alleged Kobayashi discloses “[a]n element isolation region (20) for isolating the single crystalline semiconductor layers from each other, [w]herein all the element isolation insulating films in the element isolation region (20) have the same height from the semiconductor substrate (Fig. 4E and Col. 7)” (Office Action, p. 3).

The Examiner’s characterization of Kobayashi, however, is not accurate. Kobayashi discloses, in Fig. 4E, a semiconductor device in which only one single crystalline layer designated 7 and 9 is formed on buried insulation layer 3 and between dielectric isolation regions 20. SOI layers 7 and 9, for example, are formed on buried insulation layer 3. Portions of Kobayashi’s SOI layers 7 and 9 are not insulated *from each other* by dielectric isolation regions 20 and/or insulation layer 11. Rather, dielectric isolation regions 20 and/or insulation layer 11 insulate SOI layers 7 and 9 from first Si substrate 1 and the “vertical-type power element forming region.” See Kobayashi Fig. 4E and corresponding description.

Furthermore, Kobayashi only shows a single first SOI layer 9, followed by second ultrathin film SOI layer 7, which is not the same as Applicant's claimed "wherein the first single crystalline semiconductor layers have different thickness from one another" (claim 9).

Therefore, Kobayashi does not disclose at least Applicant's claimed

a plurality of first single crystalline semiconductor layers formed on the buried insulating film; at least one second single crystalline semiconductor layer formed in the second region and in contact with the semiconductor substrate; *a plurality of element isolation regions which insulate at least one of the first single crystalline semiconductor layers from the second single crystalline semiconductor layer, and insulate the first single crystalline semiconductor layers from each other*; and element isolation insulating films in the element isolation regions having the same height from the semiconductor substrate, *and wherein the first single crystalline semiconductor layers have different thickness from one another* (claim 9) (italics added).

The Examiner has not met the essential requirements of anticipation for a proper 35 U.S.C. § 102(e) rejection, because Kobayashi does not disclose each and every element of independent claim 9. Therefore, Kobayashi does not anticipate Applicant's claim 9. Independent claim 9 is allowable, for at least the reasons set forth above, and dependent claims 11, 13, and 15 are also allowable at least by virtue of their dependence from allowable base claim 9. Therefore, the improper 35 U.S.C. § 102(e) rejection of claims 9, 11, 13, and 15 should be withdrawn.

Conclusion:

In view of the foregoing, Applicant requests reconsideration of the application and withdrawal of the rejection. Pending claims 9, 11, 13, and 15 are in condition for allowance, and Applicant requests a favorable action.

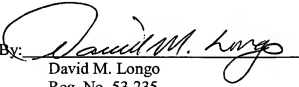
Should the Examiner continue to dispute the patentability of the claims after consideration of this Amendment, Applicant encourages the Examiner to contact the undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 21, 2005

By: 
David M. Longo
Reg. No. 53,235

/direct telephone: (202) 408-4489/